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10/827,478	04/19/2004	Heidi Marie Van Dort	DC4998CIP2	3308

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EXAMINER

GRAHAM, SHELLEY R

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

03/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/827,478

**Applicant(s)**

VAN DORT, HEIDI MARIE

**Examiner**

SHELLEY R. GRAHAM

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/DE)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1 sheet, 28 Oct 2007 and 1 sheet, 19 Apr 2004.

## **DETAILED ACTION**

### ***Status of the Application***

#### ***Election/Restriction***

1. Examiner acknowledges Applicant's arguments submitted in Applicant's response to Election/Restriction filed 26 October 2007. Groups II and III were improperly defined and are therefore considered moot. The restriction between Groups I, product claims 1-13, and Group IV, process claim 14, is maintained. Applicants elected, with traverse, the product claims of Group I, claims 1-13, and withdrew the process claims of Group IV, claim 14. Applicant's canceled claims 11 and 12 and withdrew claims 13 and 14.
2. The requirement for election of a single disclosed species is withdrawn.
3. Claims 1-10 are being examined on their merits.
4. The requirement is deemed proper and is therefore made FINAL.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being Unpatentable over claims 1-8 of copending Application No. 10/827,480. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that claimed in the co-pending applications.

6. Claims 1-10 of the instant invention and claims of the copending applications are directed to a composition comprising a hydrocarbyl functional organopolysiloxane of the given formula and a cosmetic ingredient (e.g. a sunscreen agent). Thus, Claims 1-8 of '478 anticipated the instant claims.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

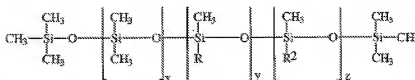
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over ROBINSON et al. (WO 02/03952, 17 January 2002).

10. With regard to claims 1-7, ROBINSON et al. teach compositions containing a skin care active ingredient in a delivery system comprised of a tacky solvent, a silicone elastomer and a carrier (see ROBINSON claim 1). Wherein the silicone elastomer is selected from dimethicone copolyol crosspolymer and dimethicone mixture, dimethicone/vinyl dimethicone crosspolymers, and mixtures thereof (see ROBINSON claim 3). Particular "dimethicone copolyols" are described on page 27, lines 3-17, as follows:



wherein R is C1-C30 straight, branched, or cyclic alkyl and R<sup>2</sup> is selected from:



and



wherein n is an integer from 3 to about 10; R<sup>3</sup> and R<sup>4</sup> are selected from H and C1-C6 straight or branched chain alkyl such that R<sup>3</sup> and R<sup>4</sup> are not simultaneously the same; and m, o, x, and y are selected such that the molecule has an overall molecular weight from about 200 to about 10,000,000, with m, o, x, and y being independently selected from integers of zero or greater such that m and o are not both simultaneously zero, and z being independently selected from integers of 1 or greater. It is recognized that positional isomers of these copolyols can be achieved. The chemical representations depicted above for the R<sup>2</sup> moieties containing the R<sup>3</sup> and R<sup>4</sup> groups are not meant to be limiting but are shown as such for convenience.

11. The definition of the "dimethicone copolyols" of ROBINSON et al. meet the defined "hydrocarbyl functional organopolysiloxanes" of the instant claimed invention described in claims 1-7.

12. While ROBINSON et al. does not define each and every polydiorganosiloxane listed in instant claim 3, one skilled in the art would have been motivated to use a variety of organopolysiloxanes available on the market. ROBINSON et al. indicate a number of organopolysiloxanes by commercial name, which would lead one skilled in the art to investigate further materials.

13. With regards to claims 8-10, ROBINSON et al. teach the use of sunscreen actives in their composition, among which cinnamic derivatives are listed as possible choices, such as ethylhexyl methoxycinnamate (see ROBINSON, page 56, lines 1-6 and lines 22-23). This material is also known as “octyl methoxycinnamate” the particular material recited in claim 10. Evidenced by the material safety data sheet available at <http://ptcl.chem.ox.ac.uk/MSDS/ET/2-ethylhexyl-4-methoxycinnamate.html>.

14. Given the above teaching, it would have been *prima facie* obvious to use the concepts of ROBINSON et al. to produce a composition comprising a hydrocarbyl functional organopolysiloxane and a sunscreen agent, particularly octyl methoxycinnamate. Silicone elastomers were known in the art, at the time of invention, to be useful components in skin care compositions.

### ***Summary***

No claims were allowable.

### ***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley R. Graham, whose telephone number is 571-270-1563. The examiner can normally be reached on M-R 8am-3pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRG  
11 February 2008

/Zohreh A Fay/  
Primary Examiner, Art Unit 1612